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10/621,015	07/16/2003	Isador H. Lieberman	CCF-6387	9116
7590 12/14/2005			EXAMINER	
TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P.			KIM, JOHN	
SUITE 1111			ART UNIT	
526 SUPERIOR AVENUE			PAPER NUMBER	
CLEVELAND, OH 44114-1400			3733	

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/621,015

Applicant(s)

LIEBERMAN, ISADOR H.

Examiner

John Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,6-8,11,14,17,21,24,30,33,34 and 36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 7/16/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3-5,9,10,12,13,15,16,18-20,22,23,25-29,31,32,35 and 37-52.

### **DETAILED ACTION**

Applicant's election without traverse of invention 1, species i in the reply filed on 11/7/05 is acknowledged. Examiner agrees with applicant that claims 1, 2, 6-8, 11, 14, 17, 21, 24, 30, 33, 34, and 36 read on the elected species. It is noted in the response filed 11/7/05, applicant elected claim 5 which depends from claim 4, where claim 4 is not elected. Thus, claim 5 is withdrawn from consideration. It is also noted that in the response filed 11/7/05, claim "114" refers to claim 14.

Claims 3-5, 9-10, 12-13, 15-16, 18-20, 22-23, 25-29, 31-32, 35, and 37-52 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### ***Claim Objections***

In claims 1, 11, and 14 there exist an inconsistency between the language in the preamble of claim 1 and that of the body of the depending claims, thus making the scope of the claims unclear. In the preamble of claim 1, lines 1-4, applicant recites "An apparatus" with first and second bones being only functionally recited, i.e. "for attaching a first bone to an adjacent second bone...", thus indicating that the claim is directed to the subcombination, "an apparatus." However, in claim 11 lines 2-4, applicant positively recites patient's sacrum and fifth lumbar vertebrae as part of the invention, i.e. "wherein one of said first and second bones is a sacrum and the other of said first and second bones is a fifth lumbar vertebrae", thus indicating that the combination, apparatus and sacrum and fifth lumbar vertebrae, is being claimed. As such, it is unclear whether

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applicant intends to claim the subcombination or combination. Since claiming the combination of the apparatus and sacrum and fifth lumbar vertebrae makes such claim(s) directed to non-statutory subject matter, applicant should amend the claims so as to remove all positive recitations of the patient's sacrum and fifth lumbar vertebrae. As such, the claim(s) would be directed to the subcombination, the apparatus, and will be considered as such for examination purposes.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,2, 7, 8, 17, 21, 30, 33, 34, and 36 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 3, 8, 9, 12, and 21 of U.S. Patent No. 6,517,774.

The difference between the application claims and the patent claims lies in the fact that the patent claims include more elements and are thus much specific. Thus the invention of the patent claims are in effect a "species" of the "generic" invention of the application claims. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the application claims are anticipated by the patent claims, they are not patentably distinct from the patent claims. As written in the patent, the anchor is equivalent to the bone screw of the application and first section and second section of a bone is equivalent to first and second bones of the application.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,2, 7, 17, 21, 24, 30, 33, and 36 are rejected under 35 U. S.C. 102(b) as being anticipated by SU 1071297 ('297, listed in the IDS).

In regards to claim 1, 2, 7, 17, 21, 24, 30, 33, and 36 '297, as understood, teaches an anchor having a platform with at least two helical spikes with a first surface transverse to the longitudinal axis of the anchor. The anchor has at least two helical spikes that extend around the longitudinal axis with a tip portion at the distal end. This anchor would meet both conditions as set by the applicant and has a third portion that

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would extend between the two bones. As seen in figure 2 (on the second page), there is a connection portion, connected to the platform, an intermediate portion and a tip portion. In figure 2, the anchor has at least two helical spikes in a cylindrical shape with a generally constant overall diameter. It also appears from figure 2 that the cross section of the spikes would be solid. Furthermore, the platform is capable of being recessed into the surface of a bone.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over SU 1071297 (listed in the IDS).

SU 1071297 ('297) discloses the claimed invention except for having a pair of helical spikes 180 degrees apart. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to construct the anchor of '297 having three spikes with the applicant's anchor of two spikes, since applicant has not disclosed that such solve any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of attaching two bones together. In re Dailey and Eilers, 149 USPQ 47 (1966). Furthermore, it would have been obvious to one having ordinary skill

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in the art at the time the invention was made to construct an anchor of '297 having a three helical spikes 120 degrees apart with an anchor having a pair of helical spikes 180 degrees apart as presented by applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over '297 in view of Schmieding (US Pat 5211647).

'297 teaches of having a helical spike apparatus. However, it fails to teach to use a cannula to insert the apparatus. Schmieding teaches "the interference screw is inserted into the cannula of the sheath before positing the sheath, and the screw and the sheath are positioned simultaneously." (col 2:33-36) It would have been obvious to one skilled in the art at the time the invention was made to construct the apparatus of '297 using the cannula in view of Schmieding to insert the apparatus to access a bone.

### ***Allowable Subject Matter***

Claims 11 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten to overcome the objection(s) set forth in this Office Action and rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892 for art cited of interest.




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Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kim whose telephone number is (571) 272-2817. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JK 

  
EDUARDO C. ROBERT  
PRIMARY EXAMINER